Attorney's Docket No. 018976-199

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	
Masatoshi Arishiro et al.	Group Art Unit: 1733
Application No.: 09/893,399	Examiner: JOHN T HARAN
Filed: June 29, 2001	Confirmation No. 6008
For: MANUFACTURING APPARATUS FOR MANUFACTURING ELECTRONIC MONOLITHIC CERAMIC COMPONENTS	Appeal No.:

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: February 16, 2005

Sir:

In accordance with 37 C.R.F. §41.41, Applicants submit a Reply Brief in response to the Examiner's Answer mailed December 16, 2004.

Applicants respectfully traverse the Examiner's statement that they failed to address the obviousness of the combined teachings of the references in view of the art of the whole and what would be common knowledge and common sense to one of ordinary skill in the art. (Examiner's Answer page 11). Applicants respectfully point out to the Examiner, as stated in the MPEP § 2143.01, "The mere fact references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As stated in In re Lee, 61 U.S.P.Q. 2d 1430 (CAFC 2002), "the search for and analysis of the prior art includes evidence relevant to the findings of whether there is teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness." Additionally, as stated in the MPEP §2143.01 "a statement that modification of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention

were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references," Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (Board of Patent Appeals and Interferences 1993). "The level of skill in the art cannot be relied upon to provide the suggestion to combine references," Al-Site Corporation v. VSI International Inc., 50 U.S.P.Q. 2d 1161 (Fed. Cir. 1999). Therefore, the mere fact that *Yoshimura* and *Takane et al.* may arguendo be combined, is not sufficient in and of itself to render the combination obvious unless the desirability of the combination is also suggested.

Additionally, Applicants respectfully traverse the Examiner's statements that the teaches of references, taken with common knowledge and common sense expected of one of ordinary skill in the art, it would be obvious to derive the claimed invention (page 14-15 Examiner's Answer). As noted in In re Lee, Id., common knowledge and common sense do not fulfill the obligation to cite references to support a conclusion. In other words, deficiencies of the cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. Furthermore, as noted in In re Lee, Id. common knowledge and common sense are not a substitute for evidence.

Applicants respectfully submit that the Examiner is only selecting bits and pieces of the references without considering the remaining teachings of those references which would lead away from the claimed invention. As the courts have stated in In re Wesslaw, 147 U.S.P.Q. 391, 393 (CCPA, 1963) quoted with approval in In re Hedger, 228 U.S.P.Q. 685, 687 (CAFC, February 1986): "It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of the other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."

As stated in the Court of Appeals for the Federal Circuit in Gore vs. Garlock, 220 U.S.P.Q. 303, 312-313 (CAFC, 1983), cert denied 486 U.S. 851: "To imbue to one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall

victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

It is, of course, difficult after having the full advantage of applicants' teaching to ignore the applicants' teachings and to rely upon the teaching of the references. However, as difficult as this may be, 35 U.S.C § 103 requires that obviousness be determined "at the time the invention was made". In addition, the CCPA and CAFC mandates in applying 35 U.S.C § 103 that the judgment of "obviousness cannot be established... absent some teaching or suggestion supporting the combination" ACS Hospital System, Inc. vs. Monefior Hospital et al., 221 U.S.P.Q. 929, 933 (CAFC, 1984). "It is impermissible... to pick and choose from any one reference only so much of it as will support a given position to the exclusion to the other parts." In re Wesslaw, In re Hedger, supra.

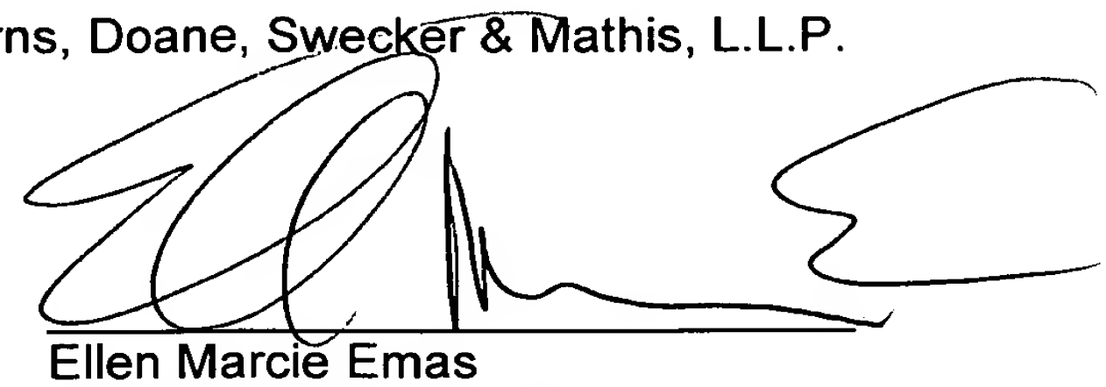
Nowhere in *Yoshimura* and *Takane et al.* is it shown, taught or suggested to combine the references as suggested by the Examiner. Nowhere in the references is it shown, taught or suggested that the trays of *Yoshimura* should be placed in a rack and in addition that the trays need a tray drawing device for drawing the trays from the rack. Additionally, nowhere in the references cited is it shown, taught or suggested that rails are arranged to guide the tray drawing device nor does any reference show, teach or suggest the desirability of using such a device. Finally, Applicants respectfully point out that no reference shows, teaches or suggests a drive for driving a rack to be raised or lowered in a vertical direction. Therefore,

Applicants respectfully request the Honorable Board of Patent Appeals and Interferences reverses the rejection of claims 1, 3 and 5-9 under 35 U.S.C. §103.

Respectfully submitted,

Burns, Doane, Swecker & Mathis, L.L.P.

Date February 16, 2005

By: 

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